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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,838	07/10/2003	Loay K. Abukwedat	LA1	2695
7590 William S. Ramsey 5253 Even Star Place Columbia, MD 21044		11/14/2007	EXAMINER NGUYEN, TRAN N	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 11/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/616,838	Applicant(s) ABUKWEDAR, LOAY K.	
	Examiner Tran N. Nguyen	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/10/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

This communication is in response to the communication filed 07/10/2003.

Pending claim(s): 1-14.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 07/10/2003 is entered and considered by Examiner.

Examiner respectfully request Applicant to use one line for each reference, with a reduced font size as necessary, and not to leave empty lines between references. See MPEP 609.06.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of copending Application No. 10817635. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Examiner submits that the two sets of claims are identical in wording.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 14 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 14, "N" is indefinite because it is unclear what "N" is.

For purposes of applying prior art, Examiner interprets this limitation to recite a positive integer greater than 3.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1-3, 12-14 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Burdick (Preferred Status for Organ Donors: A Report of the UNOS Ethics Subcommittee).

As per claim 1, Burdick teaches a method capable of creating and managing a national registry listing therein organ donor status (It is noted that organ donor status is considered to be "capable of and willing to donate an organ") for an individual (page 3 paragraph 8) who needs another organ (It is inherent that other individuals may participate for preferred status as well, and are considered to be "another donor-recipient") (page 1 paragraph 1 and throughout), comprising:

(a) creating a waitlist record for a donor who also needs an organ (It is noted that a waitlist record is considered to be "compatibility parameters and matching criteria including the organ or part of organ needed by the potential donor-recipient") (page 4 paragraph 2) and eligibility to donate a particular organ based on known disease threatening the relevant organ (It is noted that the particular organ is considered to be "the organ or part of organ which can be donated" (page 3 paragraph 8), wherein the registry is maintained by computer (page 4 paragraph 2);

(b) storing the waitlist record with preferred status for the donor (page 4 paragraph 2);

(c) invoking a one-year waiting period before granting benefit (It is noted that changing the donor's status after the one-year waiting period from waitlisted to eligible is considered to be "modifying the donor-recipient record as the donor's recipient's circumstances change") (page 3 paragraph 8).

As per claim 2, Burdick teaches specifying the needed organ, wherein the needed organ is a kidney (page 4 paragraph 5).

As per claim 3, Burdick teaches classifying the patient needing the organ as elective, about to die, or have been waiting for years (page 2 paragraph 4).

As per claims 12-14, Burdick teaches a method capable of creating and managing a national registry listing therein organ donor status (It is noted that organ donor status is considered to be "capable of and willing to donate an organ") for an individual (page 3 paragraph 8) who needs another organ (It is inherent that other individuals may participate for preferred status as well, and are considered to be "another donor-recipient") (page 1 paragraph 1 and throughout).

It is inherent that the method of Burdick is intended to result in a successful transplantation of a needed organ into a patient who may also donate another

unnneeded organ to another patient, wherein the pool of donors who participate is drawn from the national population (page 3 paragraph 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 4-7, 9-10 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Burdick in view of United Network for Organ Sharing (UNet User's Manual, hereafter referred to as "UNet").

As per claims 4, Burdick does not teach:

- (a) "step a. is performed at a transplant center";
- (b) "step b. is performed at a database server".

UNet teaches updating donor status at an Organ Procurement Organization (OPO) (It is noted that an OPO is considered to be "a transplant center") (page 1 paragraph 1). UNet further teaches a national transplant data system, wherein donors are computer-matched with potential transplant candidates (It is suggested that a database server is used to operate the national transplant data system) (page 1 paragraph 1).

All the component parts are known. The only difference is the combination of "old elements" into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of UNet within the embodiment of Burdick, since the operation of the data entry and storage method is in no way dependent on the operation of the organ donor method, and any data entry and storage method may be used in with a standard organ donor method to achieve the predictable result of updating data.

As per claims 5, Burdick does not teach "searching the database for matches between each new donor-recipient record and donor-recipient records".

UNet teaches that a team member "runs a match" to obtain a waiting list of potential transplant candidate for the donated organ (page 1 paragraph 1).

All the component parts are known. The only difference is the combination of "old elements" into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of UNet within the embodiment of Burdick, since the operation of the matching method is in no way dependent on the operation of the organ donor method, and any matching method may be used in with a standard organ donor method to achieve the predictable result of finding a match.

As per claim 6-7, Burdick does not teach searching the database using a computer located at the transplant center or the server computer.

UNet teaches updating donor status at an Organ Procurement Organization (OPO) (It is noted that an OPO is considered to be "a transplant center") (page 1 paragraph 1). UNet further teaches a national transplant data system, wherein donors are computer-matched with potential transplant candidates (It is inherent that a database server is used to operate the national transplant data system) (page 1 paragraph 1). UNet further teaches that a team member "runs a match" to obtain a waiting list of potential transplant candidate for the donated organ (page 1 paragraph 1).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of UNet within the embodiment of Burdick, since the operation of the data entry and search method is in no way dependent on the operation of the organ donor method, and any data entry and search method may be used in with a standard organ donor method to achieve the predictable result of updating data.

As per claim 9, Burdick does not teach the recited steps when a match is found.

UNet teaches:

(a) indicating disposition of donor organs (page 72 DISPOSITION OF DONOR ORGANS), wherein the organ was transplanted (Page 75 code 501-502);

(b) indicating disposition of donor organs (page 72 DISPOSITION OF DONOR ORGANS), wherein the organ was not transplanted due to an indicated reason (page 74-75 code 200-299, 503-514).

All the component parts are known. The only difference is the combination of "old elements" into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of UNet within the embodiment of Burdick, since the operation of the matching method is in no way dependent on the operation of the organ donor method, and any matching method may be used in with a standard organ donor method to achieve the predictable result of finding a match.

Burdick and UNet do not teach "reentering the matched donor-recipient records into the non-completed file into the waiting list file".

At the time the invention was made, it would have been obvious to put the recipient back on the waitlist when the transplant was not completed successfully, as taught jointly by Burdick and UNet, with the motivation of finding another organ.

As per claim 10, Burdick does not teach "a transplantation list" and "modifying the transplantation center list... with information on the transplantation and the outcome.

UNet teaches a list of donor hospitals (page 9). UNet further teaches indicating disposition of donor organs (page 72 DISPOSITION OF DONOR ORGANS), wherein the outcome of the transplant is indicated (page 74-75).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of UNet within the embodiment of Burdick, since the operation of the matching method is in no way dependent on the operation of the organ donor method, and any matching method may be used in with a standard organ donor method to achieve the predictable result of recording case disposals.

Claim(s) 8 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Burdick in view of UNet as applied to parent claim 5 above, and further in view of Pollack (Molecular HLA class I typing for UNOS laboratories).

As per claim 8, Burdick and UNet do not teach "modifying the compatibility parameters or matching criteria of the new or existing donor-recipient record" "when no match... is found".

Pollack teaches entering and matching alleles consistently (page 1 column 1 paragraph 1 and throughout).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Pollack within the embodiment of

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Burdick and UNet with the motivation of generating the correct recipient list by UNet (Pollack; page 105 column 2 paragraph 3).

Claim(s) 11 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Burdick in view of DeBruin-Ashton (6014629).

As per claim 11, Burdick does not teach "a medical team list" comprising "information concerning the experience... and location".

DeBruin-Ashton teaches a directory of group physicians for a health care provider service, wherein the directory is tailor to a patient based on the geographical location and medical specialty (It is noted that medical specialty is considered to be "experience") (Abstract).

All the component parts are known. The only difference is the combination of "old elements" into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of DeBruin-Ashton within the embodiment of Burdick, since the operation of the physician directory is in no way dependent on the organ donor registry, and a standard physician directory may be used with any donor registry to achieve the predictable result of listing the available physicians.

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Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


AMS Inc (UNOS Vitalink Business System Concept) teaches an online organ donor registry.

Any inquiry concerning this communication or earlier communications from Examiner should be directed to Tran N. Nguyen (Ken) whose telephone number is (571) 270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, Examiner's Supervisor, Joseph Thomas can be reached on (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TN 
11/10/2007


ROBERT W. MORGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600